## EXHIBIT C

B.E. Meyers & Co. v. United States.

. U.S., Court of Federal: Claims .: vers.

B.B. Meyers & Co. v. United States

Decided July 21, 2000

Trademark Office. - Reissue. .. Broader claims sought (\$ 110.1313)

or narrow (§ 125.1303)

mark belönging 10 142 competitor. See, e.g., Allen Prédr. V. Glister, 414 P.2d 93, 95 [149

to protect any type of pulsing circuitry taught device, not with any lype of pulsing circuitry? and plaintiffs cannot tely out its retixue claims? tion of "pulsing dlode" and "substantial pulsproper recapture of surrendered subject manthough telstue claims are broader than origireissue claims deals only with lens tystem of dered during bilghal prosecution, even mitted if patentee demonstrates that it did not ciaim ali inventions actually disclosed in ing current" limitations did not effect imter, in that subject metter protected in new hibits patentee from using reissue process to nal claims, since "broadening reissue" is peroriginal application, and since plaintiffs deleregaln protection for subject matter surren-Patent for infrared illuminator is not invalid for violation of "recapture rule," which proin prior art.

state Ins. Ca., 82, B3d 350, 352 (10th Cir.

he absence of Ulah Supreme Court precedent, by the lower Utah courts. See Sellers & Allapply the most recent statement of state law by the state's highest court. " (quoting Wood Eli Lilly & Co., 38 P.34 510; 513 (10th Cir.) 1994))); Taylor v. Phelan, 9. F.34.882. 887

clear gaidance from [the state's] highest count

X X X X X X

(2) Practice and procedure in Patent and Trademark Office - Reissue - Same .invention (§ 110.1305)

factual inquiry confined to objective jutent relevant inquiry is whether someone skilled in 11 eritical element of plaintiff basic invention. that is basis for reissue claim; in prosent case, and this determination involves essentially ordinary skill in art, plaimiff could fairly have cialmed newly submitted subject matter in for patent on infrared illuminator, would have considered "pulsing diode" to be recessiny or sure in connection with its original application whether reistue claims are for same invention through "objective eyes" of shmeone having original application; but for insolventant error pertinent art, after reviewing plaintiff's disclo-Federal district court in determining disclosed in oxiginal application; must examine entirety of disclosure and decide whether, manifested by original patent.

[3] Practice and procedure in Patent and

Declaration/affidayits (§ 110.0913).... Practice and procedure in Patent and Trademark Office ..... Prosecution .... Trademark Office - Reissue - Error without deceptive intent (§ 110.1303)

With the last of the second satisfy "error" requirement of Section 251; discuss each unrecessary limitation present in: singe such recitation is generally sufficient to: claims, applicant is only required to identify tigns, since declinations were reviewed und approved by 11.5. Patent, and Trademark Of., froe, and deference should be allowed in. differences between original, and reissue PTO's decision in this regard, since declare. declarations is sofficient to satisfy requireoriginal claims and omitted from resista claims, and need not form discussion solely in and filed original specification failed to recogaithough declarations do not fully specify and terns of necessary and unnocessary, limitaflors, and level of detail provided in plaintiffs. claims was not disclosed or made obvious by prior an at time of original application, and meni, piamitik, sanstind requirements of 35. U.S.C. § 251, and its implementing regule tion of founder and president of plaintiff count pany explained that attorney who prepared nize tiat subject matter covered in reissur Reissue declarations submitted by infringements of Section 251.

Particular patents — Electrical — Night : Vision devices

Re. 33,577, Meyers, invisible tight beam projector and night vision system, plainliffs motion for summary judgment that patent is not invalid granted in part. ....

ij

and John Eargo; all: of 19.5; Department of Justice Action by B.E. Meyers & Co. Inc. and Brad. summary judgment on issue of patent validity. Dawilliam Toome, Bellevenue, Washalfore plainting, and the plainting this problem, the real Chuh-l Chiang, Rank W. Hungaryassisanii attoring general, Vito J. DiPietto; director; infringement. On parties! cross-motions foc -Plaintiff's motion granted in part and, derived a in part; defendant's motion denied E. Meyers against the United States for plucht

deemed unnecessary. For the reasons set out below, plaintiff's cross-motion for summary. now complete, and further argument is ment, asserting that most of plaintiff's claims motion seeking to establish the validity of the disputed patents. Oral arguments took place: on-March 31, 2000, after which the court ordered supplemental briefing. The briefing is judgment is granted in part and denied in purt. Plaintiff. has responded .by filing a crossdevices, Defendam moves for summary judga should be dismissed because the patents No. Re. 33,572. Plaintiff!; seeks damages from ment of its patents on certain night-vision which were allegedly infringed, are invalid. Defendant's cross-motion is denied. judgment on the validity of plaintiffs patent the United States based on alleged infringe-

FACTUAL BACKGROUND

oder from burnling outs (w. 1. den from 1923) 1. 1933 Instead, the Illuminary housed in IR Light encased in a housing and then mounted atop aviewer that allowed the user to see objects ilcused the infrared light. The entire system was nal patented version of plaintiff's device, the while in operation, in order to prevent the di-Lers used as lens taps, inoduted along a viewer? The later version, referred to by the parties as Emitting Diode ("LED") which projected an IR-LED was designed to pulse off and off powered flashlights; with thinked ("IR") fil: luminated by the infrared beam. In the origides'as "infrared illuminators." The earty verthe second generation Illuminator, abandoned the use of the flashlighter filter combination. infrared beam through a lens system that for Plaintiff is a manufacture of vailous night višion devices. Among these devices. Among these devices are items-referred to by the parsions of these devices were essentially high-現場を持ちまった。 こしゃ

+212 391 0525

electromagnetic radiation into a beam with a Plaintiff later sought to have patent No. 572 ofiginal patent was too narrow in that ill incared that it believed its lens system canable of "Younds the energy from its gourbe id reissued in broader form, alleging that the cluded limitations related to the philsing of the IR LED within the original patches broadest claim. In its reissne application, plaintiff indi-

Brief E. Meyers is folketer mot president of Brief E. Meyers, inc. (1924). Me Meyers things of Well in BBM; hypers are personal to the Meyers things of the Well in the Meyers and the Meyers of the M

No. 97-120C

Supreme Court has considered the tort of un-

P&O samils in their brief that "the Utah

PATENTS.

off; and "misappropriation of goodwill" finvolve, situations in which a company attempts by selling one of its own products as that of its competitor or misappropriating a tradeto profit from the reputation of its competitor

will." (Appellants' Br. at 41.) Both "palming fair competition primarily in the context of

palming off and missperceprintion of good-

[1] Practice and procedure in Patent and

Patent construction - Claims - Broad

USPQ 795] (Useh 1966). That is not what oc-curred in the instant case, and it is not our place to expand Utah, stale isw beyond the ounds set by the Utah, Supreme Coun of, in diversity, judiction] is ... to ascertain and (10th Cir. 1993) ("As a federal bount, we are 1996) ("Our duty fas a federal court slitting in generally reticent to expand state law without

Jah willows interference claim, as to which we REVERSE and REMAND for further pro-FIRMED as to all claims except the court's in Act claim and its dismissal of P&O's grant of summary Judgment on P&G's Lanceedings in accordance with this opinion. The judgithefit of the district court is AF.

neurre and facture basis for the claim in the instant case. See Huithern Holared Gar Co. K Oroginds, 931 F.2d 678; 681-82 (10th Cx. 1991); on regressed, when there will be an apparatually to de-velop a record on the nature and factual bisses for the dismissed claims in Texas and to comfour those with the wai enicied by, the district court in the present case bar no effect on our ballist to resolve this appeal. See Prietly v. Edelman, 883 1726 438, 442 (6th Ch. 1989); Fixed a. Harrington, 533 1724 1248, 1230 (9th Ch. 1976). The resignificate implications can be addressed Cash for the Southern Dispite of Texas after Judgment 11.00

tion Washington, D.C.) for defendant 1 . vain Programme a specificação estador escolar estador de la persona est

ferred to collectively as phrinting ...

B.E. Meyers & Ca. v. United States

### Best Available Copy

(Fed. Cir.), cen. dented, 469 U.S. 821 (1984). reissue claims, because of the deference given American Holsi & Derrick Co. v. Sowa & Sons, 725 F.2d 1350, 1359 [220 USPO 763] to decisions of the patent examiner. See 14.; lar-pulsing circulty was used to control the power supply to the IR LED. Plaintiff's reisdent protection; regardless of whether particuseparate invention that qualified for indepen-

On-Sale bar

mark Office ("PTO") examiner who deals In its motion, defendant attempts to show that plaintiff's re-issue patent for the illumit nator is invalid for several reasons. It first asrule of 35 U.S.C. § 102(b) (1994) by offering to sell the patented device more than one year before it actually applied for patent protection.

sue application was ultimately granted after

being reviewed by the same Patent and Trade-

id. at. The second prong can be satisfied in at date, which means that the invention worked for its intended purpose, or (ii) by proving that prior to the critical date, the intions of the invention that were sufficiently specific to enable a person skilled in the art to mercial offer for sale prior to the critical date; least two ways: (i) by proving that the invenventor prepared drawings or other descripevidence (1) that the product embodying the claimed invention was the subject of a comfor patenting when it was offered for sale. See from was reduced to practice prior to the criti-Plaff. 525 U.S. at 67. The parry challenging 102(b), prohibits the patenting of an invenyear prior to the date of the application for the patent is referred to as the "critical date." See w. Welly Elec., Inc., 525 U.S. 55, 57 (1998). A two-prong test is used to determine whether so on-sale bar exists. See the patent must prove by clear and convincing and (2) that the claimed invention was ready from that had been on sale in the United States for mose than one year prior to the date of the application for the patent. The date that is one The on-sale bar, found in 35 U.S.C. practice the invention. See id. at.67-68... 평 summary judgment, arguing: that defendant's. Plainliff's statement of genuine issues identheories are without merit, and that, because defendant has not pointed to further flaws in its patent, the court should declare the patent disclosure in connection with its original ciently detailed. Plaintiff cross-moves for patent application. Finally, it asserts that plaintiffy reissue claims are invalid because

Second, it claims that plaintiff improperly cel matter that it surrendered in order to distinguish its device from other pre-existing inventions diving the original patent applicaion process. Third, it argues that plaintiff's reissue claims are invalid because they do not cover the same device described in plaintiffs

used the reissue process to "recapture" sub-

serts that plaintiff violated the "on-sale bar"

by plaintiff after the critical date do not mean cal date of January 30, 1984. Defendam also alleges that plaintiff had reduced its patented date, and that subsequent improvements made that the illuminator did not work for its in-Defendant alleges that plaintiff offered its patented illuminator for sale prior to the critiilluminator to practice prior to the critical lended purpose at an earlier time,

f defendant's proposed facts. There are, how...

rectly points out, many of plaintiff's "genuine

ssues" simply quibble with the phraseology ever, sufficient disputes of material fact in connection with defendant's first and third theory to render summary judgment inappropriste for either party. As for defendant's, ro-

istes a number of defendant's proposed spers

with which it disagrees, As defendant cor-

Defendant presents several different examples standable confusion about the precise product being offered at particular times. This is beinfrared spot illuminators advanced and of what it contends were commercial offers for sale, and plaintiff secks to rebut each one. its primary argument; however; is that defendant's examples are misdirected due to undercause, even as the underlying technology for Plaintiff contends that it did 500 make a prior to Rebruary 1984, and that even if it had, commercial offer for sale of the illuminator the device was not ready to patent until 1984.

Palents are presumed valid. See 35 U.S.C.

DISCUSSION

plaințis is appropriate....

maining two theories of invalidity, the court concludes that summary judgment in favor of 282 (1994). Defendant thus bears the burden. establishing lavalidity by clear and con-

vincing evidence, See Acto v. E.l. Qu Pont de Nemours, 810 F.2d 1148, 1150-51 [1 USPQ2d 1704] (Fed. Cir. 1987). Defendant also bears the burden of proof in challenging plaintiff's

with customers do not necessarily indicate that the product being referred to is the spe-cific IR illuminator for which BEM eventually evolved, the terms used to describe the devices, namely infrared spot illuminators or IR Huminators, remained the same. For this reason, according to plaintiff references to IR IIluminators in plaintiff's 1983 correspondence sought and received patent protection.

indicates that BEM is offering Mr. Killion a on an August 31, 1983 letter from BEM to a offer for sale relied on by defendant is based Mr. Killion. The relevant portion of this letter new product not yet described in BEM mar-The first example of an alleged commercial ... reting brochures:

with an IR LED. The latter is the device that? filter, or the second igeneration illuminator it was the latter, however, then the letter was an offer to sell the patented device, and the only issue remaining would be whether the and comes with a near-infrared spoilight attached to the side. The spotligin provides added illumination in minimal light situs. "near-infrared spotlight" mentioned in this eller is a first generation flashlight; with an IR was ultimately patented by BEM. If it referred to the former, then the letter to Mr. Killion was not an offer to sell the patented device. If tions. The total package sells for \$2,995.00, The parties vigorously dispute whether the ing so I will describe it to you. It is a 2nd made to accept camera lenses of your choice, has a 2" viewscreen on the back, There is one product we have just completed that you will not find a flyer on. generation night vision device similar to the Noctron V It is a more compact prackage However, I think you would find it appeal-

than the flashlight and IR filter, bechüse the light: It points to exhibits of earlier BEM: that the near-infrared spoilight reference in Killion letter is discussing a new product not Defendant points our that the reference to a product brothures, which offered to sell a flashight and an IR filter, and which referred minator." These exhibits show that the flashlight and IR filler were priced and sold separaiely. This shows, according to defendant, the Killion letter had to be something other to these items as an "infrared and white illunew product in the Killion letter encompasses both the vlewer and the near-infrared spor-

BEM brochure since at least 1982.

B.E. Meyers & Co. v. United States

ented illuminator.2 Defendant ergues that Lug-inbill's testimony, shows that plaintiff was ofrenng to sett Killion the same illuminator for which plaintiff ultimately received patent pronear—Infrared spoilight referred to in the Kil-lich letter was "the prototype infrared illumi-rator," and not the Streamlight Rashilght with an IR files. Defendant argues that the protomodel" of the IR illuminator, which used an IR LED to project a beam of infrared light that repuid be seen through a viewer. The smoking model was plainliff's earliest version of the device that eventually became the pattype illuminator referred to by Mr. Lugiobill was what both parties call the "smoking ight and IR filter had been offered and sold in mony from a Mr. George Luginbill, a formier BEM sales representative who worked with whose signature appears at the bottom of the Killion letter, testified that he believed the Defendant also relies on deposition testi-BEM unul September 1983. Mr. Luginbill tection.

From-cooper&dunham

1983, which indicate that Mr. Killion had pur-chased a Dark Invader second gene ion night viewer along with an "infrared spot illuminawas merely a flashlight with an IR filter. There the near-infrared spotlight referenced in the August 31 Killion letter must have been a new type of illuminator similar to the one refer-19 letter to Mr. Kruglak, in which Mr. Meyers possibility that the infrared spot illuminator re, according to defendant, because the infraing the Kruglak letter is not a flashilght, and because the Killion work orders indicate that tor." Defendant then points to the September ond generation Dark Invader image intensifier along with an attached infrared spot illumina-tor. Defendant argues that e physical configuration of the device in the photo refuter any red spot illuminator in the photo accompany. he had ordered an infrared spot illuminator Defendant attempts to draw a connection between the device offered in the Killion letconnection with a September 19, 1983 letter sent to a Mr. Ross Kniglak, another BEM customer. Defendant references BEM work or-ders from September 6 and September 15, in indicates he is enclosing pictures of a secier and the device offered and photographed in device itself was ready to patent at some time

prior to the critical date.

1ED would burn out after approximately one boar of continued one boar of It was called the modking model because the



plainiffs reissue declarations are not suffi-

B.E. Meyers & Co. v. United States

B.E. Meyers & Co. x United States

**56 USP**02d

B.E. Meyers & Co. w United States

₹X

the :purpose of surrender-was to distinguish matter, affirmatively surrendered during the initial : patent prosecution, particularly where the claimed invention from the prior art. See ing for a reissue claim. The law does not however, permit attempts to, recapture subject . A party may broaden its patent while apply-Mentor Corp.; 998 F.2d at 995-96. urgument, plaintiss also soughteto clarify its and that much of the 1983 sales activity. polniced to by defendant involved this FBI prootype, later abandoned, as opposed to the prototype of the patented illuminator. At orial position on this issue by arguing that nearly an unbroken chain of development for a prootype illuminator that lasted into late 1983.

Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 996 [27 USPQ2d-1521] (Fed. Cir. 1993). HISTO THE COST OF TORY IF THE COST lier; the recapture rule does .. not apply. . See See id. Determing whether a reissue claim is ements or claim limitations. See Ball Corp. v. United States; 729. F.2d 1429, .1436 [22] broadens a patent in a way that does not attempt to recapture what was surrendered earmine whether the broader aspects of the reissue claim relate to subject matter surrendered during the prosecution of the original patent. broader than a canceled claim involves more than simply counting:the number of claim el-Stein, 142 F.3d 1472. 1480 [46 UPQ2d 1641] (Fed. Cir. 1998). The second step is to deter-The first step in applying the recapture rule is determining "whether and in what respect the reissue claims are broader than the original patents." See Hester Industries, Inc. Defendant's second theory is that plaintiff's

ibility of winesses and to draw inferences from sometimes conflicting pieces of documentary evidence. The court therefore cannot appropriately enter summary judgment in favor of either party in connection with defen-

evidence requires the court to assess the

the issue as to what was for sale is one of fact, and it is contested. Proper evaluation of the

these is some contrary evidence. In the end

stantial evidence that the patented product was

Although detendant has put forward subon sale more than one year prior to palenting

and carly 1984.

broader aspects of the reissue claim attempt to recapture subject matter surrendered during patent. The dispute concerns whether the the first step towards applying the recapture rule has been satisfied, in that the reissue claims are broader than the original claims for which plaintiff received patent protection. Indeed, plaintiff concedes that the entire purpose in secking the teissue patent was to broaden the protection it had obtained in the original [1] In the present case, the parties agree that the prosecution of the original patent.

retulted in it being off more often than on; and (2) that the pulsing circuit, when on, would pulse at a substantially higher, level of power ing circuitry was already taught by the prior art; specifically Kaplan 4,290,043 and Laughlin 4,129,780. Plaintiff distinguished the prior cuit would pulse on and off at intervals that tinuously. These limitations are referred to by the parties as the pulsing diode and substan-tial pulsing current limitations, respectively. to have patent projection for a generic pulsing circuit in its original claim, because such pulsart by adding two limitations: (1) that the cirthan it would be able to sustain if left on con-In this case, plaintiff surrendered the right tions, from its broadening reissue claim. Thisaminet indeed found to be an independent in... vention, namely aslight source that, when fundiode limitation was unnecessary to begin with, and that the only surrendered subject matter relates to limitations added to the original and and unnecessary pulsine diode limitations. nal and unnecessary pulsing diode limitation. neled through a particular lens system, was capable of projecting a beam having a well defined peripheral edge. left plainiff free to protect what the PTO exwhich by definition includes the added limitstion). Plaintiff argues that the entire pulsing matter surrendered during original prosecu-

move the entire pulsing diode

smoking model. Meyers testified during his that this supports the conclusion that the illulight and IR filter an emitter. Defendant argues it, BEM informs Killion that he is receiving a Dark liveder night viewer, but not a infrared lers" were similar to the IR LEDs used in the deposition that BEM did not refer to the flash; enced in the Kruglak letter, and not, as plain-uff would have it, a flashlight with an IR filter spot illuminator. The invoice explains that the infrared spot illuminator is back-ordered because BEM had not received its "infrared emitters." Defendant, citing to Mr. Meyers' deposition testimony, argues that these "emit-BEM's November 1983 invoice to Killion. Defendant's final argument relates

light" was being touted as a new product.
In response to defendant's second, arguil negues that the new product described in the Killion letter was the second generation Dark Invades viewer, and that there is nothing dant's conjection that the "near-infrared spot-In response to defendant's first point, plainin the language of the letter to support defen-

ment, plainiff offers testimony from another BEM employee, Mr. Patrick. He was shown the Killion, letter, and testified that he believed, given the date of the letter, that it reposed to the IR LED illuminator. Plaintiff also ferred to the flashlight with IR filters as op-

that the filter appears as a separate term in the photo-gruph. Defendant contends that because the better and the physograph made a distinction between an infrared spot illuminator and an IR fashlight and filter, it would unrestocable to later that they were one and the rately and used with a Streamlight Bushight. It assens 2 Defendant also argues that the Kruglak Luner refers to an IR filter as an Item that could be purchased sepa-

duce a man-stood epos et a disunce of epproximately 400 feet. Defendant argues that the characteristics of the illuminator destribed in the Geratinoff letter are imony, buwever, is equivocal as to what he was admitletter may have been the smoking model. Mayers' tes-\* In connection with this argument defendace also points to a lotter fresh Meyers to a Mr. Puul Gerastinoid of the U.S. Array. The letter, dated November 18, 1983, the same us those described in plaintiffs new product bulled o for the putented illuminator. Defendan also points out that Mr. Meyers admitted during his deposti tion that the Illuminator referenced is the Germinnoss discusses an influend spot illuminator that could pro-

date of his order, and so it makes no sense to ary, it is illogical to assume that it was the product being offered to Mr. Killion to Authat Mr. Killion's own correspondence showed that he miscipated delivery of his night-vision device within two weeks of the estume that Mr. Killion was trying to buy a product that plaintiff would not perfect until was not perfected until the following Februgust. Along the same lines, plaintiff contends testimony states that the IR LED illuminator cornery 1984.

all of the developmental work on the patented:

illuminator actually took place during a rela-

tively compressed time period in late 1983

plainith simply relies on the arguments noted above, and also points out that Mr. Meyers estified that the words "infraied spot illuminator? were sometimes used to describe the In response to defendant's third argument Sashlight-style illuminator with an IR filter.

minator prepared for Mr. Killion in November

of 1983 was the same as the patented IR LED illuminator, and not a flashlight with an IR fil-

ever, defendant points out that this would con-November invoice. In its initial opposition being presented in a footmer that it was only because the Varo Rashlight was solictuited. Plaintiff implies that the "infrared emitter" in the Killion involce is a reference emitters" referred to IR LEDs of the type used in the patented illuminator, and not the dan's fourth argument regarding the Killion flashlight with IR filter to Mr. Killion as to the Varo flashlight. In its response, howtainily offers little in response to defenindict Mr. Meyer's testimony: that "Infrared sack-ordered that BEM did not deliver the Rachlight/IR filter combination:

nator developed for the FBI and offered to other potential customers at the same time. lainuiff argues that these letters demonstrate Federal Bureau of Investigation ("FBI"), but subsequently abandoned. At onal argument, ers from BEM dating to, early 1983 in which BEM personnel referred to a prototype illumi-As to defendant's arguments regarding plaintiff contends that these letters and demtype illuminator originally designed for the plaintiffs counsel highlighted a series of letonstrations actually involved a different protoother sales offers by BEM during late 1983, 

dicated that the librarianson was not being delivered due to the inability to obside 19. eminera, as opposed to a The parties disputes over whether this FBH illumi-nated was a hulb-baset illuminator, or lantest used some form of IR emitte, to project a beam through its Killen sile, because the November Killian invoice intrace in connection with evolutions the effect of the cal system. This distinction may be of some importack of balogep bulbs.



lendant alleges that plaintiff surrendered sub-

ect matter regarding its pulsing diode during its initial application, and then deleted the

same limitations while seeking approval for Its reissue claims. See Mentor Corp. v. Colo-

ures subject mater surrendered by plaintiff

patent is invalid because it allegedly recap-

Surrender and Recapture

dant's first theory of invalidity.

during prosecution of its original patent. De-

[521] (Fed. Cir. 1993) (discussing "recapture issue process to regain protection for subject

plass, Inc., 998 F.2d 992, 995-96 [27 USPQ2d rule," which problibits patentee from using re-

evaluated the necessity of pulsing at the time judgments, therefore, cannot properly, be

how romeone skilled in the art would have of plaintiffs original disclosure. Summary

From-cooper&dunham

manifesied by the original patent." See In re Rowand, 726-F2d 558, 560 [187 USPQ 487] (CCPN 1975). The court, however, has not

This determination involves "an essentially factoral inquity confined to the objective intent

heard testimony bit this issue, not have the pahties submitted expeit affidavite discussing 14/2, The. 142 P3d let 1479-80 ("One of the

midst Commonly asserted "errors" in support of a broadening reassue is the failure of the pat-

entec's attorney to appreciate the full scope of the invention during the prosecution of the

necessary or critical element of plaintiffs ba-393-94 [221: USPQ 952]. (Fed. Cir.:1983) sic invention. See "In re Peters, 723 F.2d 891 have considered the pulsing of the diode

B.E. Meyers & Co. v. United States

56 USPO2d

Packard Co. v. Beusch & Lomb. Inc., 1812 F.2d 1556, 1565. [11 USPQ24 1750] (Fed. Ct. 1989), cer. denied, 493 U.S. 1076 (1990). Plaintiff acknowledges that its reissue declara-tions must contain such infortigation, but comwhite that plantite declerations must phone when and why the error in its original patent application arose, as well as how and when declarations filed by Mr. Meyers in support of those claims lack sufficient detail. Defendant he, alleged епог, was discovered. See Hewleit.

tendi thai if has saitsfied the requirements of 15 U.S.C. § 251 and its implementing regulations dealing with reissue declarations. See 37 C.F.R. § 1.175 (1989).

[21] The court concludes that plaintles documented in the declarations were reviewed and apprioved by the PTO, and that deterrace should be afforded to the PTO's decision in this regard. See Azzo, 810 F.Zd at 1150-51.

[Mi. Meyets, BEM's founder and president, filed an initial declaration in which he explained that the attorney who prepared and filed the original specification failed to recognize that the patomey who prepared and of plate declaration in which he explained that the patomey who prepared and filed the original specification failed to recognize that the patomey who prepared and dependent retained elamin was not disclosed or made obvious by the prior at at the time of the griginal application. Such a recitation is tental of section 251. See Heater India generally sufficient to satisfy the "error"

the prior art, and therefore plaintiff has mot used the reissue process to (properly recaptureprosecution. Accordingly, defendant's motion for surimary judgition on the recapture issue is denied, and plainsiffs cross-motion for subject matter sumendered during the original type of pulsing circuit design that is taught by summary judgment on the same issue granted.

posed pulsing circuitry, was noo close to their

to its independent claims biccause the patent

Plaintiff's initial patent application: included a pulsing circuit element in each of its independent claims. Plaintiff added these limitations examines believed that plaintiff's original proing these limitations, plaintiff surrendered the

prior art to receive patent protection. In add-

"Original patent" requirement

BEM, acting within the appropriate time pe-Triod as defined by statute, petitioned for reissuance of the patent in broader form, on the all of the inventions actually disclosed in the soriginal application. Such a "broadening relssue" is permitted pursuant to 35 U.S.C. § 251; ally. See In re Whetter, 7901R2d 1576, 1579.

orms of pulsing circuitry had already been Subsequent to receiving its original patent,

natenied by other inventors.

essence, plaintiff conceded that more generic

circuity that did not include these features. In

right to receive patent protection for pulsing

extend patent protection to an invention that is different from the one described in BEM's contends that nothing in the original palent disclosed to anyone skilled in the art how to build an illuminator without using a pulsing circuit, and thus the reissue claims improperly Defendant also alleges that plaintiff's parents are invalid for falling to comply with the "original patent" clause of 35 U.S.C. § 251. Section 251 requires that a reissue patent be granted "for the invention disclosed in the original patent," Defendant argues that plaintiffs original patented device required a pulsing circuit in order to function, and that the absence of such pulsing circuitry maker relasule claims 35 through 46 invalid. Defendant original patent application. and the reissue statute is to be construed liber. course of prosecuting its reissue claims, plain-[229 USPQ 673] (Ped. Cir. 1986). During the matchy agreed, that a lens apparatus that progrounds that BEM's attorney had not-claimed:

equately described in the original patent application specifications. Claim 35 of the reissue in the broadest reissue claim, claim 35, is ad-Plaintiff responds that the device projected patent covers: ....

> for this aspect of its invention, plaintiff had to: delenative reference to pulsing circuity in the reissue chaims. Of course, in doing so, plain-tiff deleadd the specific pulsing diode and sub-

type of pulsing circuitty might be used in combinated with the lens system in any particular device. In order to receive protection

iff contended and the PTO examiner ultiduced a beam with a well-defined peripheral edge was in fact a separate invention cligible for patent protection, independent of whatever

said housing; and a lens system in said house. ing and aligned with said source for forming. quality of an image of a target produced by, a hancer, said device comprisings, a housing; a source, of said electromagnetic radiation-in the energy emitted from said source, into a A device for illuminating a target with a beam of electromagnetic radiation to enhance the passive visible light intensifier and image enbeam with a well defined peripheral edge.

> pulsing current limitations that had ocen added to its ariginal claim to distinguish Contrary to defendant's argument, plaindeletion of the pulsing diods and sub-

stantial

the prior art.

nation of an infrared emitter aligned with a: to subsultute for the more specific limitations: regarding a pulsing light source described in conginal patent claims. Plainiff responds issue patent improperty allows this limitation by arguing that essential element of BEM's inlens system in an illuminator bousing." Plain-Defendant focuses its argument largely on the vention protected by claim:35 is "the combireference to "a rounce of said electromagnetic radiation in said housing." arguing that the reliff insists that the patent examiner acted propany type of pulsing circuitry. During the origipatent prosecution, the examiner made

ion for its basic pulsing circuit design ber

plaintiff aware that it could not receive proteccause such pulsing circulary. was already

뎔

taught by the prior art. In this regard, nothing changed after the reissue process. Phanuiff still cannuk rely on its reissue claims to protect any

ect an improper recepture of surrendered sub-

tantial pulsing correct limitations did not ef-

with the lens system; it had nothing to do with ect matter. The subject matter protected in the

new independent reissue claims dealt only

tice by someone skilled in the lart following a review of the original patent specification. bination of elements could be reduced to pracclaims, because an invention having this com-

application, but for the inadventon error that is the basis for the reissue claim. See In re-Amos, 953 P.2d 613, 618 [2], USPQ2d, 1271] the state the second of the and decide whether through the "objective" trol circuit that pulsed an IR LED on and off art, plaintiff could fairly have claimed the newly submitted subject matter in the priginal into e behin having a well-defined pelipheral edge. These four elements can be extracted radiation," the independent claims, described in a particular manner. In determining whether the new claims are for the invention originally disclosed in the first application, the court eyes" of someone having ordinary skill in the a lens system arranged in such a way that the light from the source of radiation is focused [2] The description of plantiff's device in the independent reissue claims incorporates original specification was far more specific with respect to the source of the beam. Rather than referencing "a source of electromagnetic in the original specification referenced a conmust examine the entirety of the disclosure electromagnetic radiation in said housing, and from the original patent specification, but the four basic elements: a housing, a source of (Fed. Cir. 1991).

Defendant's final theory is that plaintiffs reissue claims are invalid because the reissue

Reissue declarations

granted in favor of either party on this issue.

connection with its original application, would evant inquiry is whether someone skilled in: As applied to the pending motion, the relhe art, after reviewing plaintiff's disclosure in a

inspirate paintiffs argument that he illuminates was more ready for paintiffs argument than BEM had successfully live tops and the pulsing control circuit take the confined to the confined t lag this combination of elements" (Like; this thus this diese orthrall passar's specification. This appears to rept.] not include pulling) "one be made from a review of the was irrelevant, because the lavention was ons ready for patential until BEM had solved the birtholis problem's problem's 1994. The mechanism was to piritalis the digite from barming out was the public control creatly as the birtholis of pilbhill? Affilm potent" requirement by envited that "an invention have moved from the independent reining elains. Plaintiff usifies this removal is consistent with the "chemia Although not dispositive at this stage, the court paters. This public control execut, tobicries, with reootes that there is significant tension between plaintiff's arguments on the "original paters" theory and the "on-tale has "theory. Plaintiff automas to avoid the op-aste but, in part, by sepaing that any sales addivity to 1983

B.E. Meyers & Co. v. United States

Fischer v. Viacom International Inc.

original petent application. This form of error has generally been accepted as sufficient to salisfy the 'eixiv' requirement of § 251.") (mternal citations ornitted).

ration" could simply have explained that the ney oversight" explanation accepted in Amos "failed to recognize" the proper scope of the Defendant seeks further explanation of how the error arose, but, citing In re Amor, 957 alleged error was due to an oversight by the prosecuting attorney. The court, however, sees no meaningful distinction between the "attorand plaintiffs allegation that its attorney F.2d at 615, admits that "an acceptable deciainvention.

tween the original iclaims and the reissue line by line identification of the difficiences between the original claims and the reissue Defendant relying on In re Constant, 827 also complains that plaintiff's declarations do omitted from the reissue claims As whitest points out, however, Constant simply requires claims, and it does not require the patence to frame the discussion solely in cerus of necessupplemental reissue declaration underrook a uff's cross-motion for summary judgment is F2d 729, [3 USPQ2d 1762] (Fed. Ct. 1987), not fully specify and discuss each unnecessary limitation present in the original claims and the patence-to identify the differences be-Sary and undecessary limitations, Plaintiff's claims, and the level of detail provided in the Supplemental declaration is sufficient to satingly, defendant's cross-motion for summary judgment on this theory is denied, and plainisty the requirencents of section 251. Accordranted

# CONCLUSION

ciercy of plaintif's reissue declarations. On or before August 18, 2000, the parties are diff. rected to provide the pour with a joint status. theory and original patent theory of invalidity mary judgment is granted with respect to the The parties' cross-inotions for summary fudgment in connection with the on-sale bar are denied. Plaibliff's cross-motion for sumrecipute theory of invalidity and the suffiseport outlining a proposed schedule for fin-ther proceedings.

District of Maryland U.S. District Court

66 USPO24

Fischer v. Viacom International Inc.

Decided August 16, 2000 No. JFM-00-357

## COPYRIGHTS

Statutory preemption 11 Elements of copyright - Federal pre-15 205.0803) TRADEMARKS AND UNFAIR TRADE PRACTICES

·-Preemption ... Unalt competition (§ 395.02)

program, detailed written description, scripi for piloi episode, character description, and "animatic" video lape are langible works that fall Within scope of copyright, since scope of "Work" that is subject of plaintiff's state aw claims, which are based by alleged misappropriation of idea for children's television ים הושנה השנים כי שנישה הניהיה כל חייו copyright, since plaintiff's written proposal for subject matter of copyright may extend to the clude uncopyrightable material, such ay ideas, partifularly when those ideas are embodied in and since plaintiffs idea therefore falls within subject matter of copyright protection, even if or intermingled with copyrightable material. idea itself would not be protected by Copyight Act

## COPYRIGHTS

2] Elements of cupyright --- Bederal premption — Statutory preemption \$ 205,0803)

TRADÉMARKS AND UNIÁIR TRADE PRACTICES

Unfaire, competitions, experiencemption (§ 395.02), while we experience of the competition of the competitio Rights asserted in plaintiffs, claim

U.S.C. \$ 301(a), Since gravament of columnis that defendants took plaintiff's ideas and used them without proper compensation or attribution, and implied contract alleged by plamiff breach of implied-in-fact contract are equivalent; to exclusive rights granted by Copyright Act, and claim therefore is preempted by 17

### Best Available Copy

breach of confidence. MTVN removed the case to this court on February 4, 2000, and for Anne Arundel County, Maryland, on Decèmber 4, 1999, asserting claims for breach of contract, violation of the Lanham Act, and filed its motion to dismiss on April 3, 2000.

duct beyond mere use of plaintiff's ideas.

COPYRIGHTS

The Pourly Circuit tecently summarized the basic principles governing the resolution of motions 16 dismiss under Federal Rule 12(b)(6):

fenses. Republican Parry v. Martin, 980 8 Rule 12(b)(6) motion should only be granted if, after accepting all well-pleaded allegations in the plaintiff's complaint as ferences from those facts in the plaintiff's ceannoi prove eny set of feets in support of his claim childing him to relief. See id. We do note, however, that for purposes of to test the sufficiency of a complaint; "importantly, [a Rule 12(b)(6) motion] does not resolve contests surrounding the facts, the due and orawing all reasonable factual insavor, it appears certain that the plaintiff as true the legal conclusions ser forth in a United Mine Workers of Am, Inc. v. Well: more Coal Corp., 609 F.2d 1083, 1085 (4th ments of a claim, or the applicability of de-F.2d 943, 952 (4th Cir. 1992). Accordingly, Rule 12(b)(6), we are not required to accept plainuiff's compulaint. See Disirici 28, Cir. 1979).

233-34 (4th Cir. 1999). Exhibits attached to ters outside the pleadings are considered by the court, a defendant's motion to dismiss will be treated as one for summary judgment under Rute 56. See Fed. R. Civ. P. 12(b)(6). Edwards v. City of Goldsborn, 178 F3d 231, the pleadings are considered part of the complaint. See Fed. R. Civ. P. 10(c). Where mat-

and his blue dog named Bluey. "This char-In the late 1970s, Sleven Fischer created an animated character team called "Steve & and His Friend the Bluesies, and a published collection of somic saries filled There's a Blue Day Under My Bed. In 1990, Fischer incorpo-Bluey, comprised of 'a guy named 'Steve' including an unpublished manuscript, Bluey copyrighted works between 1989 and 1993 rated Blue Dog Productions, Inc., to publish

This case is before the Court on a motion to collectively ... MTVN" J. The Plaintiff, Steven dismiss filed by the Defendants, Viacom International Inc. and MTV Networks, Inc. Fischer, filed a commission in the Girents Com-

Fischer v. Viacom International Inc. is no more than agreement not to use his ideas. without permission or payment, and since this alleged centract did not regulate parties' con-

(3) Elements of copyright - Federal preempilon -- Statutory preemption

(§ 205,0803)

The purpose of a Rule 12(b)(6) motion is

- Preemplion Unfair competition

TRADEMARKS AND UNFAIR TRADE

PRACTICES

(§ 395.02)

plaimisf describe parties acting at arm's breach of confidential arrangement, which is children's television program, are equivalent to exclusive rights granted by Copyright Act, length, with no prior dealings, no promise of Iween parties gave rise to "implied" duly of Kights asserted in plainliff's claim-for based on alleged misappropriation of idea for and claim therefore is preempied by 17 U.S.C. § 301(a), since plaintiff does not allege that parties formed explicit agreement of trust or confidentiality, and since facts alleged by confidentiality, and no employment or personal relationship that could give rise to dury of trust, and thus do mot support plaintiffs contention that dealings and relationships beconfidentiality.

Action by Steven Fischer and Blue. Dog Productions Inc. against Viacom International inc. and MITV Networks Inc. for violation of confidence. On desendants' motion to dismiss. Lanham Act, breach of contract, and breach of Granted in part and denied in part. A SALESTAN

Harold M. Walter and Boy'd K. Rutherford. of Dydings & Rosenberg, Baltimore, Md., for plaintiffs.

& Tremaine, New York, N. Y.; Michael S. Li. bowitz and Michael John Collins, of Thomas & Libowitz, Baltimore; for defendants. Bizabeth A. McNamara, of Davis,

Mots, J.